

### REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application. Claims 1-6 and 8-27 are currently pending in this application. No new matter has been added by way of the present amendment. For instance, the amendment to claim 1 is supported by the Specification at, for example, page 28, lines 21-29. New claims 18-19, 21-23 and 25-27 find support at pages 82-84 of the present Specification. Similarly, newly added claims 20 and 24 are supported by the Specification at, for example, pages 122-123. Accordingly, no new matter has been added.

In view of the amendments and remarks herein, Applicant respectfully requests that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

### Issues Under 35 U.S.C. 103(a)

Claims 1-6 and 8-15 stand rejected under 35 U.S.C. § 103(a) as being obvious over Ito et al. (U.S. 6,150,084) (hereinafter Ito '084) in view of JP 11-149136 (hereinafter JP '136) or Adin et al. (U.S. 6,054,260) (hereinafter Adin '260). Applicant respectfully traverses.

The Examiner asserts that Ito '084 discloses a photothermographic material containing non-photosensitive silver halide, photosensitive silver-halide, a reducing agent for silver ions, a binder, and a compound of formulae (1) to (3), as claimed in the present invention.

The Examiner acknowledges that Ito '084 fails to teach or suggest the presently claimed compound of formula (I), and relies on the teachings of JP '136 and Adin '260 to overcome this deficiency.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

The present invention is directed, *inter alia*, to a photothermographic material comprising a non-photosensitive silver salt of a long-chained aliphatic carboxylic acid having 15-28 carbon atoms, a photosensitive silver halide, a bisphenol reducing agent for silver ions and a binder on one surface of a support, which comprises at least one compound represented by formula (I) and at least one second compound represented by one of formulae (1), (2) or (3) (see, for example, claim 1). Moreover, the present claims require that the substituents in Formula I meet the following limitations: X is a silver halide adsorption group or light absorption group which contains at least one atom of N, S, P, Se or Te, L represents a (k + n)-valent bridging group

containing at least one nitrogen atom (e.g. claim 1), A represents an electron-donating group, B represents a leaving group containing a -COO- group (e.g. claim 1), A-B is dissociated or deprotonated after oxidation to generate a radical A', k represents 0-3, m represents 0 or 1, and n represents 1 or 2, provided that when k = 0 and n = 1, m = 0. Applicant respectfully submits that the prior art of record fails to teach or suggest to a photothermographic material as presently claimed. For this reason alone, the present rejection should be withdrawn.

Moreover, Applicant submits that the unexpectedly superior results achieved by the present invention, compared to the cited art, rebut any hypothetical *prima facie* case of obviousness allegedly established by the Examiner.

As evidenced by the Examples and Comparative Examples discussed at pages 122-152 of the present Specification, as well as the Declaration Under 37 C.F.R. 1.132 filed on June 29, 2007, present compounds I-62, I-84, I-26, I-34, I-47 and I-91 (encompassed by present claim 1) exhibit high developed silver grain density and covering power, superior fog and Dmax, high sensitivity and high  $\gamma$ , as well as little increase of fog during storage (*see* also Tables 13 and 14 at pp. 145 and 151, respectively).

Evidently, the prior art of record fails to render the present invention obvious. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

#### Additional Comments

This Response presents new claims 18-27. Applicants submit that these claims are allowable at least for the reasons discussed above with regards to claims 1-17.

Moreover, Applicant submits that Ito '084 in view of JP '136 or Adin '260 fails to teach or suggest a photothermographic material comprising a Zn metal ion with the non-photosensitive silver salt of a carboxylic acid (e.g. claim 21), or comprising a photosensitive silver halide having a core/shell structure as presently claimed (e.g. claim 25).

Thus, Applicant submits that all presently pending claims are in condition for allowance. A Notice of Allowability is thus respectfully requested.

**Obviousness-Type Double Patenting**

Claims 1-6 and 7-15 stand rejected under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1-20 of U.S. Patent No. 6,764,816 (Ohzeki) in view of Ito '084. Applicant respectfully traverses this rejection.

Initially, Applicant notes that claim 7 was cancelled by way of the amendment filed on October 2, 2006. Accordingly, the rejection of this claim is moot.

Moreover, as noted above, the present invention achieves unexpectedly superior results compared to the cited art. Thus, this rejection is overcome at least for the same reasons as discussed above. Additionally, Applicant notes that the combination of the claimed two types of compounds achieves synergetic improvements in sensitivity and reduction of Dmin after leaving, which would not have been obvious to one skilled in the art.

Thus, Applicant submits that this rejection is improper and should be withdrawn. Reconsideration and withdrawal of this rejection are thus respectfully requested.

**Conclusion**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Marc S. Weiner, Reg. No. 32,181 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

Dated: July 7, 2008

Respectfully submitted,

By 

Marc S. Weiner

Registration No.: 32,181

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant